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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,454	12/04/2000	Amy W. Lasck	PC-0028 US	6223
27904	7590	02/18/2004	EXAMINER	
INCYTE CORPORATION 3160 PORTER DRIVE PALO ALTO, CA 94304			YU, MISOOK	
			ART UNIT	PAPER NUMBER

1642

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/729,454	Applicant(s) LASEK ET AL.	
	Examiner MISOOK YU, Ph.D.	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-37 is/are pending in the application.
4a) Of the above claim(s) 22,23,29,30 and 32-36 is/are withdrawn from consideration.
5) ☒ Claim(s) 37 is/are allowed.
6) ☒ Claim(s) 24,27,28 and 31 is/are rejected.
7) ☒ Claim(s) 26 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The finality of the rejection of the last Office action mailed on 5/29/2003 is withdrawn and prosecution is re-opened.

Election/Restrictions

The prosecution history indicates applicant elected group I drawn to DNA, with species SEQ ID NO:1 (with traverse (see Paper NO:5).

Claims 22, 23, 29, 30, and 32-36 remain withdrawn for reason of record.

Claims 22-37 are pending. Claims 24-28, 31, and 37 are under consideration.

This Office action contains new grounds of rejection.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 112, Maintained

Claims 24, 27, 28, and 31 remain rejected for reason of record under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant in the Appeal briefs filed in 12/08/2003 reiterates the argument of record i.e. one in skilled in the art would recognize naturally-occurring variants. This argument is not persuasive for reason of record. The prosecution history indicates that applicant is claiming the allelic variants that the specification do not describe what the chemical structure look like.

The Following Is the New Ground of Rejection

The indicated allowability of claims 25, and 26 are withdrawn in view of the new rejection.

Claims 24, 25, 27, and 28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO:1, does not reasonably provide enablement for any other polynucleotide comprising degenerate codons encoding SEQ ID NO:1 protein. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The claims are drawn to an isolated polynucleotide encoding SEQ ID NO:1. As the prosecution history indicates instant SEQ ID NO:1 has use for detecting colon cancer. This rejection is based on the failure of the specification whether the protein encoded by instant SEQ ID NO:3 is actually expressed. The specification also fails to teach any correlation between over-expression of the polynucleotide i.e. SEQ ID NO:1 to over-expression of the protein i.e. SEQ ID NO:3.

However, those of skill in the art recognize that expression of mRNA, specific for a tissue type, does not necessarily correlate nor predict equivalent levels of polypeptide expression. In fact, evidence abounds in which protein levels do not correlate with steady-state mRNA levels or alterations in mRNA levels. For example, Fu et al (EMBO Journal, 1996, Vol. 15, pp. 4392-4401) teach that levels of p53 protein expression do not correlate with levels of p53 mRNA levels in blast cells taken from patients with acute myelogenous leukemia, said patients being without mutations in the p53 gene. Further,

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Powell et al (Pharmacogenetics, 1998, Vol. 8, pp. 411-421, abstract) teach that mRNA levels for cytochrome P450 E1 did not correlate with the level of corresponding protein, and conclude that the regulation of said protein is highly complex. Vallejo et al (Biochimie, 2000, vol. 82, pp. 1129-1133, abstract) teach that no correlation was found between NRF-2 mRNA and protein levels suggesting post-transcriptional regulation of NRF-2 protein levels. These references serve to demonstrate that the analysis of levels of polynucleotide transcripts cannot be relied upon to anticipate levels of protein expression. Further, Jang et al (Clinical and Experimental Metastasis, 1997, vol. 15, pp. 469-483, abstract) teach that further studies are necessary to determine if changes in protein levels track with changes in mRNA levels for metastasis associated genes in murine tumor cells, thus providing further evidence that one of skill in the art cannot anticipate that the level of a specific mRNA expressed by a cell will be paralleled at the protein level due to complex homeostatic factors controlling translation and post-translational modification.

Thus, the predictability of protein translation and its possible utility as a diagnostic are not necessarily contingent on the levels of mRNA expression due to the multitude of homeostatic factors affecting transcription and translation. Therefore, absent evidence of the protein's expression including the correlation to a diseased state, one of skill in the art would be unable to predictably use the polypeptides in any diagnostic setting without undue experimentation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MISOOK YU, Ph.D. whose telephone number is 571-

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272-0839. The examiner can normally be reached on 8 A.M. to 5:30 P.M., every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne C Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LARRY R. HELMS, Esq.
PRIMARY EXAMINER

MISOOK YU, Ph.D.
Examiner
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